It is believed that no fees are required for these submissions. However, should the U.S. Patent and Trademark Office determine that any fee is due or that any refund is owed for this application, the Commissioner is hereby authorized and requested to charge the required fee(s) and/or credit the refund(s) owed to our Deposit Account No. 04-0100.

REMARKS

This submission is in response to the Restriction Requirement dated February 26, 2003. Claims 1-25 are pending. Consideration of the above identified application, in view of the following remarks, is respectfully requested.

The Examiner has required a restriction of the pending claims to one of the following groups:

I. Claims 1-11 *(claim 25 should also be included because it is also drawn to a cell)*, drawn to recombinant cell.

II. Claims 12-25 (sic, *claim 25 should not be included with this group because it is drawn to a cell, not to a method)*, drawn to methods of screening useful compounds using the recombinant cell of group I above.

In order to be fully responsive to the Requirement for Restriction, Applicants hereby provisionally elect, with traverse, to prosecute claims 1-11 and 25,

corresponding to Group I. Applicants respectfully point out that claim 25 should be included in Group I, not in Group II. Claim 25 is not directed to a method of screening, the subject matter of Group II, but to a recombinant cell. As indicated in the Examiner's explanation of the subject matter embraced by Group I, claims directed to recombinant cells are a part of Group I. Thus, claim 25 should be considered with the claims of Group I and is herein elected along with claims 1-11.

Applicants respectfully traverse the Requirement for Restriction and reserve the right to petition therefrom under 37 C.F.R. § 1.144. Applicants respectfully request reconsideration of the Restriction Requirement to allow prosecution of Group II with elected Group I.

Groups I and II must be examined together pursuant to 35 U.S.C. §103(b)(2), under which a patent issued on a biotechnological process shall also contain claims directed towards the composition of matter utilized by that process. 35 U.S.C.§103(b) mandates that "a biotechnological process [in the present case, methods for identifying a compound] using or resulting in a composition of matter that is novel under Section 102 and nonobvious under Section 103(a) shall be considered non-obvious if claims to the process and the composition of matter are contained in .... the same application for patent ..." 35 U.S.C.§103(b)(1)(A). Using the novel products of Group I in any process requires determining the novelty of the products of Group I. Once the novelty of these products is established, methods of using these

products are patentable. *In re Ochiai*, 37 USPQ 2d. 1127 (Fed. Cir.1995). Thus, the process of using the recombinant cells should be considered with the product claims.

Under Patent Office examining procedures, "if the search and examination of an entire application can be made without serious burden, the Examiner ***must*** examine it on the merits, even though it includes claims to distinct or independent inventions." See, M.P.E.P. § 803 (emphasis added). The groups of claims designated by the Examiner (*i.e.*, Groups I and II, *supra*) do not define products and methods for using such products with biological properties which are distinct or which warrant separate examination and searches. Rather, the claims represent a web of knowledge and continuity of effort that merits examination in a single application. A thorough search of the subject matter of claims 1-11 and 25 of Group I would necessarily include a search of the subject matter of the claims of Group II as they all involve the same recombinant cells. The conjoint examination and inclusion of all of the claims of Groups I and II in the instant application is therefore appropriate and would not present an undue burden on the Examiner.

Further, pursuant to 37 C.F.R. § 1.141(b), "the process of using [a claimed product] may be joined with the claims directed to the product and the process of making the product even though a showing of distinctiveness between the product and the process of using the product can be made."

Hence, a search of the features of the product recited the claims of

Group I would necessarily and inescapably require a search of the subject matter of Group II. The rules provide for such conjoint examination of product and process of using claims. The case law also supports examination of all of the claims, and 35 USC § 103(b) requires it for biotechnological inventions, which is the case here. Accordingly, Applicants respectfully request that the Examiner withdraw the Requirement for Restriction.

CONCLUSION

In view of the above remarks, it is respectfully requested that the application be considered on its merits and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

Heather Morrow Ettlinger
Reg. No. 51,658 for Paul Fehlner

Paul F. Fehlner, Ph.D.
Reg. No. 35,135
Attorney for Applicants

DARBY & DARBY, P.C.
Post Office Box 5257
New York, NY 10150-5257
Phone (212) 527-7700